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IN THE

Supreme Court of the United States

October Term, 1976

No. 76-1628

CHISHOLM-RYDER COMPANY, INC., and NEW YORK STATE GRAPE PRODUCTION RESEARCH FUND, INC.,

Petitioners,

vs.

LEWIS MANUFACTURING COMPANY, LEO J. LEWIS, WILLIAM L. LEWIS, MARK LEWIS and LEWIS MANUFACTURING COMPANY,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

Petitioners pray that a writ of certiorari issue to review a judgment order of the United States Court of Appeals for the Third Circuit entered in the above-entitled case on January 17, 1977.

Citations to Opinions Below

The judgment order of the Court of Appeals is unreported but is reprinted in the Appendix hereto (pp. 41a-42a). A first opinion and order of the District Court filed July 17, 1975 is reported at 398 F.Supp. 1287 and is reprinted in the Appendix hereto (pp. 1a-31a). An order correcting opinion of the District Court filed August 18, 1975 is unreported but is reprinted in the Appendix hereto (pp. 32a-33a). A memorandum opinion and order of the District Court filed March 31, 1976 is unreported but is reprinted in the Appendix hereto (pp. 34a-40a).

Jurisdiction

The judgment order of the Court of Appeals was entered January 17, 1977. A petition for rehearing *in banc* was denied on February 24, 1977 (Appendix, pp. 33a-44a). The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

Questions Presented

1) Whether 35 U.S.C. § 253, which permits the disclaimer of patent claims, requires that a disclaimer be filed *promptly*?

2) Whether the *mere* filing of a disclaimer under 35 U.S.C. § 253 permits a court to infer that the disclaimed claims were invalid?

3) Whether deliberate concealment of an item of prior art from the Patent and Trademark Office can be inferred *solely* from the fact that the patentee had knowledge of such item?

Statute Involved

The provisions of Sections 253 and 288 of the 1952 Patent Act (35 U.S.C. §§ 253, 288) are involved and read as follows:

"253. *Disclaimer*

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted."

"§ 288. *Action for infringement of a patent containing an invalid claim*

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent and Trademark Office before the commencement of the suit."

Statement of the Case

In 1969, petitioners sued respondents in the Western District of Pennsylvania for infringement of Shepardson patent No. 3,380,236 issued April 30, 1968 for "Apparatus for Harvesting

Grapes". The patent matured from an application filed in 1965 which was a continuation-in-part of an application filed in 1961.

Respondents admitted infringement of every claim so that only validity of the patent was in issue at the time of trial.

About one year after commencement of the suit, eight of the original eighteen claims of the patent were disclaimed.

After a bench trial, the District Court rendered an opinion and entered an order on July 17, 1975 invalidating the retained ten claims of the patent on the ground that seven of them were met by a single item of prior art, which was unknown to the inventor during prosecution of the patent. Petitioners did not appeal this part of the ruling.

The remaining three claims of the patent were invalidated on the inference that the inventor, a professor of agricultural engineering at Cornell University, deliberately concealed from the Patent Office five items of purported prior art which he was charged with knowledge of, since three were publications of articles which he co-authored and two were theses of graduate students whom he supervised. Of these five items, only one thesis was dated early enough, although quite immaterial in content, to be eligible as prior art against said parent application. The District Court admitted that no prior art disclosed the subject matter of said three claims.

The District Court assumed that two of the five non-disclosed items of alleged prior art would have disclosed the subject matter of the eight disclaimed claims, in spite of petitioners' unchallenged showing that these claims were supported by the disclosure of said parent application which predated such two items and therefore these two items could not possibly be prior art against these disclaimed claims.

Following a denial of petitioners' motion under FRCP 59(e) to alter the judgment only as to the invalidation of said three claims, petitioners appealed.

The Court of Appeals for the Third Circuit seemingly perfunctorily affirmed the District Court by merely stating: "The findings of fact of the district court are not clearly erroneous and the court applied correct legal standards." A petition for rehearing *in banc* was denied.

ARGUMENT

Reasons for Granting the Writ

This case should be reviewed on certiorari because it involves important questions concerning interpretation of Sections 253 and 288 of the 1952 Patent Act, which represent a significant departure from the previous law pertaining to patent disclaimers. This Court has not yet rendered any decision involving these new Sections, and therefore the questions are ones of first impression.

Moreover, the Court of Appeals for the Third Circuit, through its affirmance of the District Court, expressly applied principles involved in the old disclaimer law deliberately intended by Congress to be omitted from the new law.

The District Court relied on the statement in *Strong v. General Electric*, 434 F.2d 1042 (5th Cir. 1970), *cert. denied*, 403 U.S. 906 (1971), that the requirements for the application of Sections 253 and 288 are that the invalid claims which do not render all claims invalid must be those "made inadvertently or by mistake and which are promptly disclaimed".

The Court in *Strong* relied on *Marconi Wireless Telegraph Co. of America v. United States*, 320 U.S. 1, 57 (1943), which involved the old disclaimer law (35 U.S.C. §§ 65, 71, repealed 1952).

In *CPC International, Inc. v. Standard Brands Inc.*, 385 F.Supp. 1057, 1061-1062 (D.Del. 1974), the Court rejected the contention that *Strong* required "without deceptive intention" to mean only when "made inadvertently or by mistake and—promptly disclaimed". Moreover, that Court determined that the change in law indicated a congressional intent to abolish the necessity for disclaimer as a prerequisite to suit.

The old law requirements of "inadvertence, accident or mistake" have been replaced by "without deceptive intention" and there is no longer any requirement for a "prompt" filing of a disclaimer, as there was under the old law. See Federico, *"Commentary on the New Patent Act"*, 35 U.S.C.A. (§§1-110) 1, 47.

This change in law is discussed in Dunner, Gambrell and Kayton, 4 *"Patent Law Perspectives"*, page G-1296 (1968-69 Annual Review), which also criticizes the District Court's decision in *Strong* [305 F.Supp. 1084 (N.D.Ga. 1969)] as giving a defendant broad power to effectively cancel or annul a patent, something which had previously been reserved to the Government.

Thus, there are important changes in law which are ignored or not appreciated by at least the Third and Fifth Circuit Courts of Appeal, which should be settled by this Court.

The Courts below in the case at bar not only assume that a disclaimer is an admission of invalidity of the disclaimed claims, but seemingly infuse deceptive intent into the act of disclaimer so as to invalidate the entire patent in suit. If every

disclaimer were automatically cloaked with deceptive intent, the disclaimer statute would be vitiated and meaningless.

To the knowledge of petitioners' counsel, this Court has never spoken on the question of any inference to be drawn from the filing of a disclaimer.

Judge Learned Hand, in *Foxboro Co. v. Taylor Instrument Co.*, 157 F.2d 226, 227-228 (2nd Cir. 1946), *cert. denied*, 329 U.S. 800 (1947), discusses a line of decisions supporting the principle that the filing of a disclaimer is not an admission by the patentee that the disclaimed matter was not patentable.

Moreover, 35 U.S.C. §253 states that a filed disclaimer "shall thereafter be considered as part of the original patent". This seems to be in keeping with the pronouncement of this Court, with respect to a prior disclaimer statute, in *Dunbar v. Myers*, 94 U.S. 187, 194 (1876), that after a proper disclaimer has been made the patent is construed as though the matter disclaimed had never been claimed.

The legal implications to be made from the filing of a disclaimer under the current statute should be settled by this Court. This is another reason for the grant of certiorari.

In the case at bar, the District Court stated that "deceptive intention", as used in 35 U.S.C. §§253 and 288, is more than mere technical fraud, as might be revealed by a finding of obviousness, and requires actual fraud or other inequitable conduct, citing *Walker Process Equipment, Inc. v. Food Machinery and Chemical Corporation*, 382 U.S. 172 (1965). Yet the District Court made no finding that Shepardson, with wrongful or deceitful intent, failed to disclose said five items of alleged prior art to the Patent and Trademark Office. Indeed, there is not a scintilla of evidence to support such an intent. Rather, the District Court inferred that type of intent

from Shepardson's mere chargeable knowledge of these five items, notwithstanding its lip service to "deceptive intention" requiring actual fraud or inequitable conduct.

Petitioners' counsel believes that *Walker* is the last pronouncement of this Court on the subject of fraud in the procurement of a patent, which is being asserted as a defense with ever increasing frequency in patent infringement cases. In recent years, Courts have varied widely in their decisions with respect to what constitutes compliance with a duty of disclosure to the Patent and Trademark Office based on candor and good faith, as established by this Court in *Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806 (1945).

No court has departed so far from applicable principles enunciated by this Court in *Precision* and *Walker*, as the Courts below in the case at bar, by inferring that because Shepardson knew or should have known about three publications and two theses, he deliberately concealed them from the Patent and Trademark Office, with the effect of invalidating claims which were admitted by such Courts not to be anticipated by these items or any prior art.

The Court of Appeals seemingly ignored, although expressly called to its attention, the following statement made by the district court in *Paeco Inc. v. Applied Moldings, Inc.*, ... F.Supp. ...., 189 USPQ 281, 282-283 (E.D.Pa. 1976):

> "The mere failure to cite prior art references, without more, does not automatically convert a good faith effort to obtain a patent into a deliberate, intentional withholding or a conscious concealment consistent with an intent to mislead the Patent Office—(citing cases)."

The practice of alleging fraud in the procurement of a patent as a defense in infringement litigation, is becoming so

commonplace that this Court should take the opportunity afforded by the case at bar to pronounce the principles that determine what acts of omission, as opposed to acts of commission such as affirmative misrepresentations, invalidate a patent, in order realistically to control application of the defense and to avoid aberrative court decisions, as in the present case. This is another reason for the grant of certiorari.

In this connection, the Patent and Trademark Office, in order to improve the quality and realiability of issued patents by strengthening examining procedures, has been provoked recently to adopt a rule, 37 C.F.R. 1.56(a), defining a duty to disclose to the Office information which an individual is aware of which is material to the examination of a patent application. The avowed purpose is to codify an Office policy consistent with the prevailing case law in the federal courts, and which may afford guidance to courts as well (See 955 O.G. 1055). Under 37 C.F.R. 1.56(d), an application can be struck from the files of the Office if there was any violation of the duty of disclosure through bad faith or gross negligence. Information withheld as a result of an error in judgment or inadvertence is expressly stated not to be bad faith.

The grant of certiorari will enable the Patent and Trademark Office to be guided by this Court in expressing Office policy for the future administration of the patent law.

Salient Errors In the Courts Below

If, in applying 35 U.S.C. §§ 253 and 288, the District Court, as sanctioned by the Court of Appeals, considered seven claims invalid because anticipated by a single item of prior art which Shepardson was unaware of and not one of the five

non-disclosed items, such seven claims were invalid without "deceptive intention", *as a matter of law*, and thus the remaining three claims of the patent should not be rendered invalid under these Sections. The Courts below held such remaining claims invalid even though it was conceded they were not anticipated by any prior art.

If, in applying 35 U.S.C. §§ 253 and 288, the Courts below considered the disclaimed claims to be invalid with "deceptive intention" so as to invalidate the retained claims, this conclusion was based both on an unwarranted assumption that Shepardson admitted they were invalid stemming solely from the fact of disclaimer, and on such Courts' erroneous interpretation that the statute requires a disclaimer to be filed promptly and that Shepardson's disclaimer could not have been so filed because filed after commencement of the suit.

In trying to equate deliberate concealment to "deceptive intention", the Courts below failed to find any act of actual fraud or inequitable conduct, an essential element by their own admission, and made an unwarranted inference that Shepardson deliberately failed to disclose to the Patent and Trademark Office the five items of alleged prior art solely because he was involved in the creation of such items and therefore knew of them or was chargeable with knowledge of them. Chargeable, or even actual, knowledge in connection with an act of omission is manifestly quite a different thing from a conscious or deliberate withholding laced with wrongful or deceitful intent.

Invalidation of all claims of petitioners' patent in suit brought about by the aforementioned glaring errors of the Courts below demands correction to give justice to petitioners, and this further warrants this Court to grant certiorari.

Conclusion

Petitioners respectfully request that this petition for a writ of certiorari be granted.

Respectfully submitted,

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APPENDIX TO PETITION

Opinion and Order of the United States District Court

(Filed July 17, 1975.)

IN THE UNITED STATES DISTRICT COURT
For the Western District of Pennsylvania

CHISHOLM-RYDER COMPANY, INC. a corporation, and NEW YORK STATE CONCORD GRAPE PRODUCTION RESEARCH FUND, INC. a corporation,

Plaintiffs,

vs.

LEWIS MANUFACTURING COMPANY, INC. a corporation, and LEO J. LEWIS, an individual, and WILLIAM J. LEWIS, an individual and MARK LEWIS, an individual, and LEWIS MANUFACTURING COMPANY, a partnership,

Defendants.

Civil Action No. 47-69 ERIE.

Weber, *J.* Jul 17 1975

This is a suit for infringement of patent. Jurisdiction is based on 28 U.S.C. 1338(2). Venue is properly laid in this court.

Defendants have admitted that each of the claims in the patent in suit reads on their grape harvesters and hence are infringed if the patent is valid. The defendants defend on the grounds that the claimed invention is obvious under 35 U.S.C. § 103 and was anticipated by being described in a printed publication more than one year prior to the date of application for patent in the United States under 35 U.S.C. § 102(b). The defendant also claims that the patent is invalid

by reason of a fraud upon the Patent Office for the failure of the applicants to disclose to the Patent Office the prior art of which they had knowledge.

The patent in question results from a continuation-in-part application of the inventor based on a parent application of an earlier date. The parent application, Serial No. 99,507 entitled "Grape Harvesting Machine" was filed on March 30, 1961 by Mr. Shepardson; this application was repeatedly rejected until final rejection on August 19, 1964, whereupon an appeal was filed. Before that appeal was dismissed the inventor filed a second application at Serial No. 449,394 called a continuation-in-part application. On August 31, 1966 an interference was filed and further proceedings were held before the Patent Office. The patent in question was finally granted on April 30, 1968, U. S. Patent No. 3,380,236. The patent in question contained eighteen claims. Subsequent to the filing of this suit claims 3,4,7,9,10,13,16 and 18 were disclaimed. The alleged infringement concerns ten claims on which claim number 1 is in independent form and on which claims 2,5,6,8,11,12,14 and 15 are dependent, directly or indirectly. Claim 17 is an independent claim.

A continuation-in-part (CIP) application is one which includes both matter common to the parent application and matter not common to or not included in the parent application. The claims in the CIP application which find support in specification of the parent application are entitled to the filing date of the parent application. The claims in the CIP application which do not find support in the parent application are entitled to no earlier filing date than that of the filing date of the CIP application. 35 U.S.C. § 120.

The claims of U. S. Patent No. 3,380,236 which were not disclaimed and which are claimed to be infringed in this action read substantially as follows:

Claim 1. A machine for harvesting clustered fruit from vineyards where rows of vines have been trained on a generally horizontal trellis wire extending longitudinally of each row in such manner that a curtain of fruit bearing canes hangs from said longitudinal trellis wire, comprising a frame movable through the vineyards alongside each row of vines, generally horizontal bar means arranged at a level close to the level of the longitudinal trellis wire of the row being harvested, and means on said frame arranged to support and project said bar means longitudinally into the side of the curtain of canes of the row being harvested, and to move said bar means transversely, thereby to shake the fruit from said curtain of canes of the row being harvested, and means gathering and transporting away the fruit shaken from the curtain of canes being harvested.

Claim 2. Claim 1 wherein said bar means is moved upwardly.

Claim 5. Claim 1 wherein said bar includes a hub rotatable about a generally upright axis and arms secured to said hub to project in radial planes therefrom, said arms traversing a major portion of a half circle while engaged with said curtain of canes being harvested.

Claim 6. Claim 5 wherein said hub is freely rotatable and said arms are at least four in number in spaced relation around said hub, each arm entering the curtain of canes being harvested at a generally horizontal acute included angle relative to the row being harvested and being moved in response to the forward movement of said frame and in response to the restraint of the curtain of canes being harvested through a plane generally perpendicular to said row and thence to a generally horizon-

tal acute included leaving angle relative to said row, whereby the movement of the outer end of each arm approximates the general speed of the frame.

Claim 8. Claim 1 wherein said bar means comprises at least one arm the upper surface of which, on entering the curtain of canes of the row being harvested, is at an acute included angle to the horizontal and slopes downwardly toward its end which is projected into the curtain of canes being harvested, whereby such projection tends to lift the curtain of canes being harvested.

Claim 11. Claim 1 wherein said gathering and transporting means includes inner and outer walls arranged generally parallel with the line of movement of the machine and which are spaced from each other to form a way through which the said curtain of canes being harvested passes and which contains said bar means.

Claim 12. Claim 11 wherein that wall which is arranged on the truck side of said curtain of canes has upper and lower portions between which the trunks of the vines pass.

Claim 14. Claim 1 wherein said bar includes a freely rotatable hub and arms fixed to said hub to project radially therefrom in spaced relation to one another, and wherein said support and shake means comprising means supporting said hub for free rotation about a generally upright axis and means shaking said hub supporting means up and down and positioning said hub alongside said curtain of fruit bearing canes in such position that its arms progressively enter endwise into the side of said curtain below said longitudinal trellis wire, the axis of said hub being at an acute included angle with reference to the vertical to slope downwardly toward the curtain of

fruit bearing canes, whereby the entering elevation of the outboard ends of said arms into the side of said curtain of fruit bearing canes is lower than the leaving elevation thereof so that upon moving along within the curtain of fruit bearing canes the arms are brought into engagement with the underside and lift said longitudinal trellis wire.

Claim 15. Claim 14 wherein said acute included angle is in the order of about 30°.

Claim 17. In a machine for harvesting fruit from vines supported in a row formation comprising in combination, a rotatable vine-impinging means carried by the machine, means mounting said impinging means for intermittent impingement against said vines, means associated with and movable independently of said vine-impinging means for imparting reciprocatory motion to the vine-impinging means, a power source carried by the machine, and a driving connection between said power source and said independently movable means.

Our examination of Claim 1 of the patent in question, with the disclosures of the pertinent parts of the parent application, to determine the critical date for the disclosures relative to the freely rotatable spiked wheel which is inserted into the grape vines underneath the trellis wire, leads us to the conclusion that Claim 1 of the patent must be limited to a spiked wheel so spaced that one spike which is already imbedded in the vine foliage causes rotation of the hub supporting it and the succeeding spike, to project such succeeding spike into the vine foliage. Thus, a foliage-imbedded spike constitutes the "means on the frame arranged to . . . project said bar means longitudinally into the side of the curtain of canes of the row being harvested" as called for by Claim 1.

Taking the critical date for anticipation as being April 16, 1964, one year prior to the date of the patent in question, the

defendants have asserted nine items of purported prior art either in support of their argument that the patent is invalid under § 102(b) or under § 103. § 102(b) provides that a person shall not be entitled to a patent if "the invention was . . . described in a printed publication . . . more than one year prior to the date of application for patent in the United States." § 103 provides that a patent may not be obtained although the invention is not identically disclosed or described as set forth in § 102 of this title, "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

The purported prior art asserted by the defendants, either in support of its defense of publication under § 102(b) or § 103 is as follows:

1. Lamouria Patent No. 2893,194—Application filed August 24, 1956, Patent issued July 7, 1959.

2. Tubbs Patent No. 2933,323—Application filed November 6, 1958, Patent issued July 25, 1961.

(These two references were cited by the patent office. Under 35 U.S.C. § 102(e) the effective date of a patent filed by another for consideration as prior art is the filing date by said other person of an application for such patent).

3. Erie-Times Newspaper article, January 10, 1960.

4. Grape Belt Newspaper article, March 3, 1960 (same text as below).

5. Paper: "Grape Harvesting Research at Cornell", by Shaulis, Shepardson and Moyer, delivered at New

York State Horticultural Society, Proceedings, 105th Annual Meeting 1960, held January 19-22 and January 27-29, 1960, pp. 250-254, date of publication of printed bound volume not shown. (This item is identical to No. 4 above in text, but includes photographic illustrations).

March 30, 1960
One Year prior to
parent application.

6. Paper: "Grape Harvesting Research at Cornell-II", by Shaulis, Shepardson and Moyer, delivered at New York State Horticultural Society, Proceedings of 106th Annual Meeting held January 17-19, January 25-27, 1961, pp. 250-255, date of publication of printed bound volume not shown.

7. Agricultural Engineering Article, "Mechanical Grape Harvesting", by Shepardson, Studer, Shaulis and Moyer, February 1962 issue.

8. A Thesis by John Richard Padget, dated June 1959, catalogued in the Mann Library of Cornell University, July 21, 1959.

9. A Thesis by Henry Eugene Studer, dated February 1962, catalogued in Mann Library of Cornell University, February 15, 1962.

Our comparison of the claims of the patent in question with the parent application brings us to the conclusion that the subject matter of claims 12, 14 and 15 of the patent in suit is not disclosed in the Shepardson parent application and such claims are therefore subject to a declaration of invalidity under § 102(b) if the invention was patented or described in a printed publication prior to April 16, 1964. With respect to

the remaining claims of the patent in question the critical date for the application of § 102(b) would be March 30, 1960. Claim 14 differs from the parent application and from the prior art in its recitation of a specific orientation for the axis of the hub of the shaker wheel. Plaintiffs have referred to this as a "tipped axis claim". The axis of the hub is not only (1) tipped downwardly toward the curtain of the canes, but is also (2) tipped downwardly toward the rear of the harvester. It is further described as follows: Col. 16, lines 54-62,

> "[T]he axis of said hub being at an acute included angle with reference to the vertical to slope downwardly toward the curtain of fruit bearing canes whereby the entering elevation of the outboard ends of said arms into the side of said curtain of fruit bearing canes is lower than the leaving elevation thereof so that upon moving along within the curtain of fruit bearing canes the arms are brought into engagement with the under side and lift said longitudinal trellis wire."

Claim 15 solely recites that it describes a machine as set forth in Claim 14 wherein "said acute included angle is in the order of about 30°."

Therefore, the prior art which would have made this invention obvious or the publication which anticipated this invention with respects to claims 1,2,5,6,8,11 and 17 must be those which antedated the parent application of March 30, 1961, by one year.

Plaintiffs concede that the article "Mechanical Grape Picker Does Its Job But Still Leaves Problems To Be Solved" which appeared in the March 3, 1960 edition of *The Grape Belt*, is a printed publication having a date of March 3, 1960, which is more than one year prior to the date of filing the Shepardson parent application.

With regard to the defense of prior publication a general observation on the evidence may serve to clarify the nature of the claimed publications. The Inventor of the "Apparatus for Harvesting Grapes" upon which patent number 3,380,236 was granted is E. S. Shepardson, a professor of Agricultural Engineering at Cornell University, Ithaca, New York. He, together with a graduate student studying under him and in cooperation with representatives of the New York State Agricultural Experiment Station at Geneva, New York, and the New York State College of Agriculture at Ithaca, New York, began in 1957 a cooperative project to study mechanical harvesting of grapes. There was no attempt to keep the progress of the cooperative study secret and in the *Erie Times News* of Erie, Pa., a newspaper of general circulation, on Sunday, January 10, 1960, an extended description of the machine appeared. It described a demonstration of a model of the machine exhibited recently at the Fredonia, Chautauqua County, New York, experiment station of "what appears to be a soundly principled mechanical grape picker." Two months following this another article appeared in the March 3, 1960 issue of *The Grape Belt*. The article in *The Grape Belt* recited the substance of a progress report made by Professor Shepardson and his colleagues, and gives what is reported to be a verbatim report of the progress report. This is the same report that was read at the January 1960 meeting of the New York State Horticultural Society, and published (with photographs) in the printed record of the *Proceedings*. The text of the *Grape Belt* article (except for the bibliographical references and photographs) is identical to the printed text of the *Proceedings*.

The January 1960 paper was entitled "Grape Harvesting Research at Cornell", together with photographs of the machine in question, including a close-up photo of the spiked

wheel vibrator, was published in the printed and bound volume of the *Proceedings* of that meeting. The volume does not reveal the date of its publication, but a similar article entitled "Grape Harvesting Research Cornell—II" by the same authors also appears in the printed volume of the *Proceedings* of the New York State Horticultural Society at their 106th Annual Meeting in January 1961, and the 1961 article makes reference to the publication of the *Proceedings* of the 1960 meeting. In any event, the publication in the *Grape Belt* on March 3, 1960 establishes a date of publication.

In the February 1962 issue of *Agricultural Engineering* there is an article six pages in length, co-authored by the inventor and his colleagues describing in detail with accompanying photographs and drawings the development of the machine.

Meanwhile, high above Cayuga's waters, graduate students were at work under the supervision of Professor Shepardson. Bearing the date June 1959, a typewritten thesis was presented to the faculty of the graduate school of Cornell University for the degree of master of science by John Richard Padget. A copy of this thesis was deposited in the Mann Library of Cornell University and indexed in its card index. A copy of said thesis has been offered in evidence and admitted to be genuine but objections to its consideration as a publication have been made. The copy offered in evidence has an attached certification by the Librarian of the Mann Library in affidavit form attesting that it was catalogued into the Library on July 21, 1959. A reference to this thesis appears at the end of the paper published by the inventor and his colleagues in the *Proceedings* of the 105th annual meeting of the New York State Horticultural Society which was a paper delivered at the January 1960 meeting of that society. It is described as an "unpublished masters thesis".

Also offered into evidence and subject to the same objection as were posed to the prior thesis was a thesis entitled "Mechanical Harvesting of Concord Grapes" bearing on the cover page the date of February 1962, and presented to the faculty of the graduate school of Cornell for the degree of master of science by Henry Eugene Studer. This thesis was also deposited in the Mann Library of Cornell University and an index card prepared and the offered document contains the certification in affidavit form of the Librarian of the Mann Library indicating that it was catalogued into the Library on February 15, 1962. Footnote number 2 of the article published in the *Proceedings* of the New York State Horticultural Society 106th annual meeting held January 1961, refers to Studer as the source of certain material reported therein in these terms, "some data taken from unpublished material for MS Thesis, expected in June 1961".

We will refer to the objections to the consideration of the two graduate theses as publications at a later point in this opinion.

Before proceeding with further consideration of the details of the claims of the patent in question and their anticipation by prior publication or their obviousness we must consider certain controlling rules of law applicable to this case.

A patent is presumed to be valid and the burden of proof of invalidity lies upon the one contesting that issue. 35 U.S.C. § 282. However, this presumption of validity is significantly weakened if not completely destroyed where the patent office has not considered the most pertinent prior art.

> "Where relevant prior art is not considered by the Patent Office, the presumption of validity of the patent is weakened or overcome."
>
> *Philips Electronic & Pharmaceutical Indus. Corp. v. Thermal Electronics Indus.*, 450 F.2d 1164, 1176 [3rd Cir. 1971].

See also *Gomez v. Granat Bros.*, 177 F.2d 266 [9th Cir. 1949]; *O'Leary v. Liggett Drug Co.*, 150 F.2d 656 [6th Cir. 1945]; *Gerald M. Friend, Inc. v. Walsh*, 141 F. 2d 180 [2nd Cir. 1944].

It is particularly important to note this qualification upon the presumption of validity in this case where so much of the published prior art, authored by the inventor and his colleagues and his graduate students was not placed before the patent office for its consideration. When Mr. Stone, a retired patent examiner, who examined the application for the patent in question testified that he was unaware of the pertinent prior art and was allowed to express the opinion that had he been so aware he would have not permitted the claims to issue as they did.

A second principle of law applicable to the present case is that which mandates close scrutiny of combination patents, those claiming an assembly of old elements combined in a novel and unobvious manner. Plaintiffs admit that this is a combination patent by reciting in their brief "each claim of the patent in suit is a combination claim and its validity does not depend upon the novelty of any or all of its elements individually, but rather upon the novelty of the combination." In such a case,

> "The claims in issue must be scrutinized 'with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements.' *Great Atlantic & Pacific Tea Company v. Supermarket Corp.*, 340 U. S. 147, 152 [1950]."
>
> *Sperry Rand Corp. v. Knapp-Monarch Co.*, 307 F.2d 344, 345 [3rd Cir. 1962].

The Supreme Court has stated the rule as:

> "The conjunction or concert of known elements must contribute something; only when the whole in some way

> exceeds the sum of its parts is the accumulation of old devices patentable. . . . This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned, and there is nothing to indicate that the lower courts scrutinized the claims in the light of this severe test.
>
> Neither court below has made any finding that old elements which made up this device perform any additional or different function in the combination than they perform out of it. . . . Two and two have been added together, and still they make only four."
>
> *Great Atlantic & Pacific Tea Co. v. Supermarket Corp.*, 340 U. S. 147, 152 [1950].

In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co. Inc.*, 396 U. S. 57 [1969], the Supreme Court again treated this question:

> "We conclude that while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented. We conclude further that to those skilled in the art the use of the old elements in combination was not an invention by the obvious-nonobvious standard. Use of the radiant-heat burner in this important field marked a successful venture. But as noted, more than that is needed for invention." (pp. 62-63).

The defense of prior publication has been offered here. The plaintiffs contend that the rule of *Seymour v. Osborne*, 78 U.S. 516 [1870] should be applied, requiring that "the descriptions and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the

art or science to which it pertains, to make, construct, and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent." (p. 555). While the rule of *Seymour v. Osborne* was developed in the case of a foreign publication, we find that the same stringency is applied to American publications.

> "For a prior publication to be sufficient to defeat a patent it must exhibit a substantial representation of the invention in such full, clear, and exact terms that one skilled in the art may make, construct and practice the invention without having to depend on either the patent or on his own inventive skills."
>
> *Philips Elec. & P. Indus. Corp. v. Thermal Indus.*, 450 F.2d 1164, 1169 [3rd Cir. 1971].

And

> "It is sufficient that the description in the printed publication impart to the person of ordinary skill sufficient information which, coupled with the disclosures of the prior art, would enable him to devise the invention without further genuine inspiration or undue experimentation."
>
> *Struthers Scientific & Int. Corp. v. Rappl & Hoenig Co.*, 453 F.2d 250, 255 [2nd Cir. 1972].

A prior printed publication cannot be read in the light of knowledge gained from a reading of the patent in suit in order to anticipate or render obvious to one skilled in the art the subject matter of the claim of a patent. *Rich Products Corp. v. Mitchell Foods, Inc.*, 357 F.2d 176, 180 [2nd Cir. 1966]. And the subject matter of a patent claim is not anticipated or rendered obvious by the disclosure of a prior publication if such person must experiment in order to attempt to build a machine in accordance with such disclosure. *Allied Research Products Co. Inc. v. Heatbath Corp.*, 300 F. Supp. 656 [N.D.Ill. 1969].

The *Erie Times* article of January 10, 1960, is a printed publication appearing more than one year prior to the filing date of the Shepardson parent application of March 30, 1961. As a prior publication it does not meet the test of *Seymour v. Osborne, supra.* We do not regard the absence of pictures, photographs or drawings, as mentioned in *Seymour v. Osborne,* to be fatal if the verbal description is otherwise adequate but we do not find the verbal description sufficient to enable a person to duplicate the machine described in the patent. The *Erie Times* article describes the machine as experimental and while it describes the "shaking" effect it does not describe the multi-spoked hub which enables the invention in question to penetrate and travel along the grapevines underneath the trellis wire to provide the shaking effect which is the essential feature of the patent in question. However, the *Erie Times* article, while not meeting the test of a prior publication under § 102(b) of the statute, may still be considered as part of the prior art.

The Grape Belt newspaper article of March 3, 1960, is a printed publication having a date more than one year prior to the filing date of the parent application for the patent in question here. *The Grape Belt* article does not have drawings or photographs but does contain a verbatim account of a manuscript report prepared by Professor Shepardson and his colleagues for future publication in complete form with photographs and drawings. From our examination the quoted report of Professor Shepardson and his colleagues in the Grape Belt article is identical with the text of the printed article in the *Proceedings* of the 105th Annual Meeting of the New York State Horticultural Society in 1960, except that the

Grape Belt article does not contain the three photographs which are contained in the Horticultural Society publication.

While the plaintiffs have objected to the admission of the *Proceedings* of the 105th annual meeting of the New York State Horticultural Society of 1960 as a prior publication because the printed book of the *Proceedings* offered into evidence contains no indication of the date of its publication and distribution, we believe that the publication date of the identical text in the *Grape Belt* on March 3, 1960, establishes a firm date of publication. Furthermore, in Interference Proceeding No. 95,578 when the patent in question was subject to an interference proceeding, the inventor Shepardson filed an affidavit with the patent office sworn to on October 25, 1966, that the first date upon which the first written description of the invention was made was on or about January 19, 1960, in a paper which was read to the 1960 meeting of the New York State Horticultural Society, a copy of which is attached to the affidavit and which is identical in text to the *Grape Belt* article and the article in the 1960 *Proceedings* of the Horticultural Society.

The Grape Belt and the 1960 Horticultural Society articles, after describing the impracticality of a vibrating clamp firmly attached to the trellis wire to shake the grapes, continues with the following description:

> "The system now used is a continuously vibrating, rotating spiked wheel, which is positioned under the trellis wire. The rotation of the spiked wheel is brought about through vine contact as the machine moves along the row. The fruit is collected in a collector-conveyor carried under the vine curtain." (Pg. 1, col. 3, pg. 8, col. 1).

Plaintiff argues with respect to the article in *Grape Belt* (and thus as to the 1960 *Proceedings* of the Horticultural Society) that the article does not meet the printed publications standards of *Seymour v. Osborne* in that it does not disclose a spike of a spiked wheel as being generally horizontal as required by Claim 1, or that the spike is arranged close to the level of the trellis wire as required by Claim 1, nor means for moving the spike transversely of itself as required by Claim 1, nor that the direction of vibration is upwardly as required by Claim 2, nor that the hub has at least four arms as required by Claim 6. It appears to us that these requirements of the various claims must be self-evident if the machine is to operate in the manner generally described in the two published articles. The spiked wheel must be generally horizontal in order to lift the trellis wire which is a horizontal wire and in order to rotate as it passes along the row of vertical vines. It must of necessity be close to the trellis wire, and if it is to shake the trellis wire it must vibrate vertically. Defendants' expert, Crankshaw, testified that the disclosures of the *Grape Belt* article made obvious to a person skilled in the arts the elements of Claims 1, 2 and 5 of the patent. As to Claim 6, which requires that the hub has at least four arms, Crankshaw testified that while the Grape Belt article does not disclose a specific number, it is nevertheless obvious that if the spiked wheel is to be rotated by contact it should have sufficient spokes so that the new spoke entering has in fact begun to enter before the leaving spoke has in fact left the vine. Two spokes would not accomplish this and it is obvious that at least four spokes would be required.

Claim 8 of the patent in question describes a bar means which enters the curtain of canes at an acute included angle to the horizontal and slopes downwardly toward its end. This projection into the curtain of canes tends to lift the curtain of canes being harvested.

To us the import of this claim is that the spoke of the spiked wheel is tapered. Defendants' expert Crankshaw testified that the *Grape Belt* article referred to a "spike wheel" and that the term spike means something that is tapered along its length to a point. It thus appears to us that a tapered spoke would be obvious.

We, therefore, find that with respect to the state of the prior art Claims 1, 2, 5 and 6 of the patent in question are obvious.

Claim 11 of the patent requires that the gathering and transporting means of the machine includes inner and outer walls arranged generally parallel with the line of movement of the machine and which are spaced from each other to form a way through which the said curtain of canes being harvested passes and which contains said bar means. Claim 12 adds that the wall is arranged on the trunk side of said curtain as upper and lower portions between which the trunks of the vines pass. Claim 11 of the patent in question reads on the original disclosure and is entitled to the protection of its filing date. The inner and outer side walls which form a trough through which the falling grapes are conducted to the conveyor belt are clearly shown in Figures 1 and 2 of that application. However, the parent application does not disclose that the wall on the trunk side of the curtain of canes has upper and lower portions between which the trunks of the vines pass as set forth in Claim 12 and therefore this claim is subject to attack for obviousness or by reason of publication prior to April 16, 1964, one year before the date of the patent in question. The *Grape Belt* article states that the fruit is collected in a collector-conveyor carried under the vine curtain. Plaintiffs argue that this does not eliminate the positioning of the collector-conveyor transversely to the line of movement of the machine or some other disposition wherein the walls

would not be generally parallel to the line of movement of the machine. The witness Crankshaw testified that it would have been obvious to dispose the conveyor belt and therefore the side walls of the collector along a line parallel to the trellis wire of the grapes or the line of movement of the machine.

Claim 12 of the patent in question depends upon Claim 11 and recites that the wall which is arranged on the trunk side of the curtain of canes has upper and lower portions between which the trunks of the vines pass. This is not revealed in the *Erie Times* article or the *Grape Belt* article and does not read on the original disclosure. It would only be invalid by a publication or by obviousness of the state of the art before one year prior to the filing date of the patent in question, April 16, 1965.

Our examination of the *Grape Belt* article does not reveal the teaching of the upper portion of the wall of the trough nor do we find reference to it in the 1961 *Proceedings* of the New York State Horticultural Society. A reference to the problem appears in the article in *Agricultural Engineering*, February 19, 1962 issue by the inventor and his colleagues (Studer, Shaulis and Moyer) in that on page 68, column 1 of said article, the following description appears:

> "The outer wing (and its nose piece) must be flexible so that it can yield, when vine and post obstructions are hit, and then return to its initial position. The photograph of the 1961 experimental model appearing as figure 2 on page 67 of the Agricultural Engineering article shows a view of the outer wall but does not show it *arranged in upper and lower portions so that the trunks of the vines can pass between them.*" (emphasis supplied).

This is a clear publication prior to April 16, 1964.

The Studer thesis discusses the problem of berries separated from the clusters of grapes having velocities imparted to them which caused them to be thrown over the conveyor wings with attendant losses. It continues "in order to reduce these losses, the height of the left wing on the conveyor was increased to 70 inches from the ground. This resulted in little or no loss occurring on that side. The front of the conveyor and the right wing were fitted with deflectors to accomplish more effective channeling of the vines." [DX 15, p. 14]. The defendants' expert, Mr. Crankshaw, testified that it would have become apparent to an operator of the machine to erect such an upper wall to prevent the loss of fruit whether it was decided to do so in the initial design of the harvester or whether it was done after the harvester had been placed in operation and the spill-over was apparent to the operator. It is, therefore, obvious.

Claims 14 and 15 were clearly not disclosed in the parent application. The effective date of the bar of prior publication would be prior to April 16, 1964. Claim 14 calls for a hub freely rotating about a generally upright axis in such position that its arms (the tapered spikes of Claim 8) enter endwise into the side of the curtain below the longitudinal trellis wire whereby the entering elevation of the outboard ends is lower than the tearing elevation so that the entering arms contact the trellis wire and lift it. This is accomplished by having the axis of the hub at an acute included angle with the vertical. Claim 15 reads on Claim 14 with the acute included angle being in the order of about 30°. Figure 3 of the patent shows this application and Figure 7 shows the hub and the angle of its axis in detail.

The plaintiffs refer to this as the tipped axis claim and recite that the axis of the hub is not only tipped downwardly

toward the curtain of canes but also tipped downwardly toward the rear of the harvester.

Defendants assert that this claim is obvious in view of the prior art as revealed by the *Agricultural Engineering* article and the Studer thesis.

Figure 3 (p. 67) of the February 1962 article in *Agricultural Engineering* is a drawing of "Essential Elements of the Cornell Grape Harvester." The spokes of the spiked wheel are shown as tipped down in front and up at the rear by a tilt in the axis of the vertical hub toward the rear of the machine. The angle of tilt is shown as 5°. A photograph designated as Figure 3 (p. 252) of the 1960 *Proceedings* shows "close up of the spiked wheel vibrator" which also shows a noticeable tilt toward the rear. One of the authors of the Agricultural Engineering article, along with the inventor, was H. E. Studer and the Studer master's thesis of February 1962 at Cornell University shows as Figure 5 (p. 11) the identical drawing as Figure 3 of the *Agricultural Engineering* article, showing the tilted axis of the spiked wheel at 5°. Studer describes the reason for the tilt:

> "The spiked wheel was originally designed so that the spokes lay in a plane parallel with the ground. In regions of high negative slope of the trellis wire, this resulted in the spokes rotating from beneath the wire to the top of the wire, with resultant loss of wire contact. An inclination of the spoke plane of five degrees to the horizontal reduced the frequency of the contact loss." (p. 12).

So far these references only concern a tilt in a single direction. There is no mention of a tilt tipping downwardly toward the curtain of canes.

Crankshaw testified that the function recited by Claim 14 is that the outboard ends of the spikes enter the curtain of canes at a lower elevation than in leaving so that they come in contact with and lift the horizontal trellis wire. This function is performed by the downward tilt of the axis to the rear, as shown in Figure 3 of the *Agricultural Engineering* article. Thus the downward tipping of the axis toward the curtain secures no new or beneficial results and therefore cannot serve as the basis of patentability. *Great A & P Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 [1950].

While Figure 3 and Figure 7 of the patent show a conically shaped spiked wheel this is not recited in Claim 14 and, therefore, any benefits from the use of this design cannot support an argument that Claim 14 is unobvious.

Studer explains the use of a spiked wheel tilted downwardly toward the curtain of canes in another context. The spiked wheel which is described in the various claims to which we have referred above is the shaker unit which vibrates the longitudinal trellis wire to separate the grapes from the vine. At page 46 of his thesis, Studer recites:

> "If the trellis wire were to be lifted up to the level of the spiked wheel as the machine moved down the row, there would be no need for automatic vertical positioning of the shaker unit."

After reciting the benefits to be achieved by lifting the trellis wire, he continues:

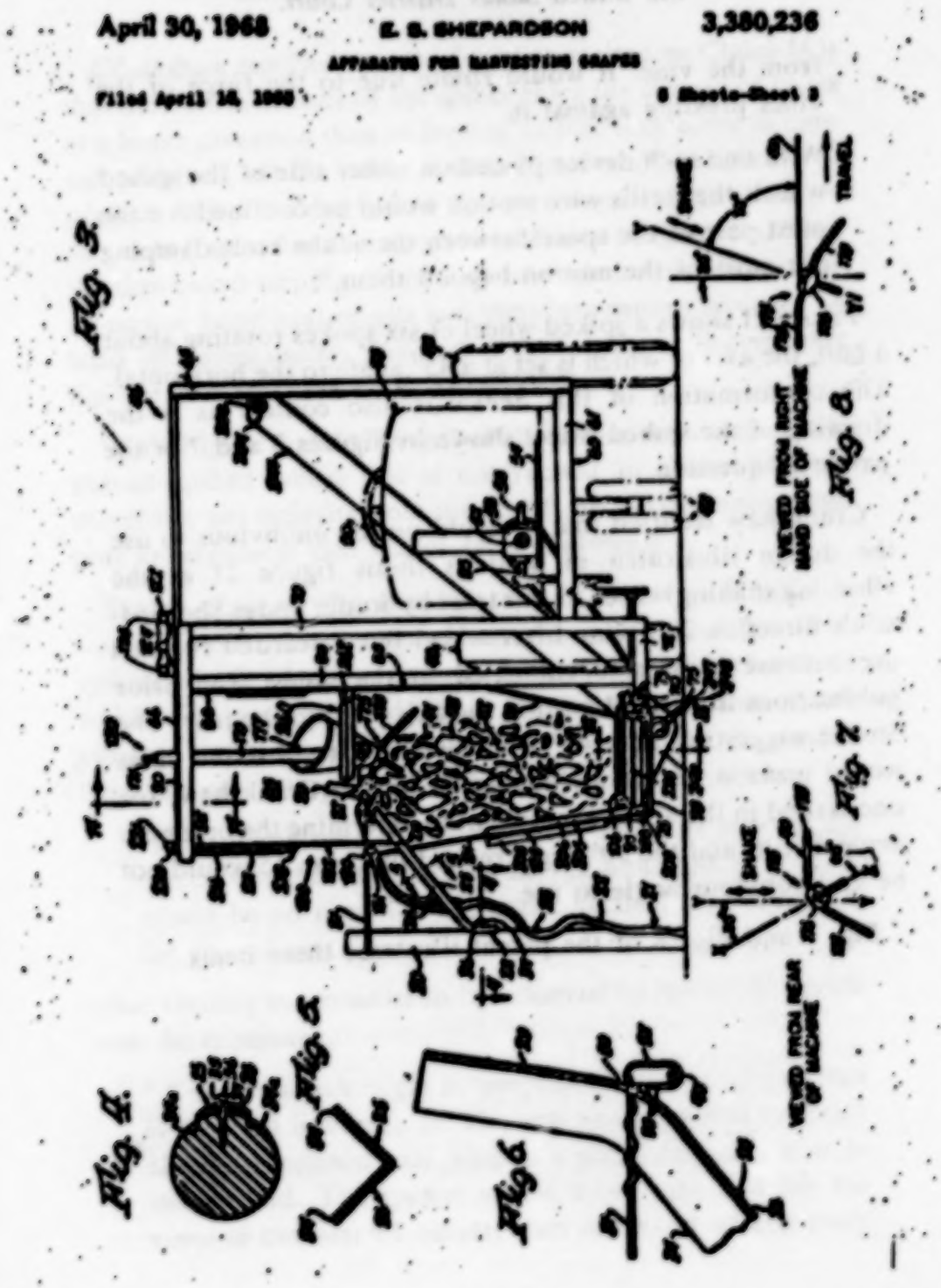
> "A device which might accomplish the lifting of the vines is depicted in Figure 21. The unit would be free to rotate about an inclined axis lying in a plane perpendicular to the ground. The spokes would move into and lift the vines to the desired height, then move out of and away

> from the vine. It would rotate due to the force of the vines pressing against it.
>
> With one such device placed on either side of the spiked wheel, the trellis wire motion would be confined for the most part to the space between them, the reels damping out most of the motion beyond them."

Figure 21 shows a spiked wheel of six spokes rotating about a hub, the axis of which is set at a 45° angle to the horizontal. The conformation of this device is also conical as is the drawing of the spiked wheel shown in Figures 3 and 7 of the patent in question.

Crankshaw testified that it would not be unobvious to use the design illustrated in Studer's thesis figure 21 as the vibrating shaking wheel. It was tried by Studer under Shepardson's direction as a vine lifter wheel but discarded for that use because it became entangled in the vines. The prior publications illustrated a tilt in the axis of 5° to the rear. The Studer suggestion of a 45° tilt downward toward the vines would make it not unobvious, according to Crankshaw, for one skilled in the art to experiment to determine the optimum angle of tilt, and the 30° angle recited in Claim 15 would not be an unobvious angle to use.

Fig. 7 and Fig. 8 of the patent illustrate these items.



If we reject the Studer thesis as a prior publication because the date of its availability in the Cornell University Library is not established, we must consider the thesis in another aspect. We have previously noted that the presumption of validity is destroyed where relevant prior art was not considered by the patent office. However, such a great quantity of the prior art was not disclosed to the patent office in this case that we must carefully examine whether there was an intentional withholding of material facts from the Patent Office.

The plaintiff only cited two patents, the Tubbs Patent, No. 2,993,323 and the Lamouria Patent, No. 2,893,194.

Yet at the time of the parent application the inventor had reason to know of the following:

His student, Padget, had completed a thesis for a Master's degree, under his supervision, which thesis was deposited in the Cornell University Library system, in the Mann Library, of the College of Agriculture of the University. Professor Shepardson is familiar with this library. He knows that there is a card index system for everything deposited there, and a university-wide index system. The copy of the thesis supplied as an exhibit contained a copy of the index card, and the binder of the thesis contained cataloguing references. The thesis was found there by Mr. Mark Lewis. He secured a copy by a request forwarded through the Erie Public Library. Mr. Shepardson cited the Padget thesis in his references at the end of his paper delivered at the 105th *Proceedings* of the New York State Horticultural Society in January 1960; again in his references in the 106th *Proceedings* in January 1961, and again in his article in *Agricultural Engineering* in February 1962.

Shepardson had delivered a paper in January 1960 to the 105th Proceedings of the New York State Horticultural

Society. The manuscript was typewritten. Each year's *Proceedings* is printed in a bound volume. The bound volume printed the full text of the paper, with bibliographic references, and photographs. The identical text (without photographs or bibliography) appeared in a printed newspaper article in the *Grape Belt,* a periodical circulated in the area where the machine was intended to be used, on March 3, 1960.

The following year Shepardson again appeared in January 1961 at the 106th meeting of the New York State Horticultural Society and delivered another paper detailing later developments, and referring to the former article. It was also published, with photographs and bibliography.

In February 1962, an article by Shepardson and others, including H. E. Studer, appeared in the journal *Agricultural Engineering,* a technical magazine of agriculture. This article also contained photographs and diagrams, and referred in its bibliography to the Studer thesis which was expected to be published in June of 1962.

H. E. Studer was a candidate for the Master's degree in the School of Agriculture; studying under Shepardson's supervision. His thesis, which had also been found in the Cornell Library by Mr. Lewis through the card indexing system, and a copy was secured by defendants through the Erie Public Library.

Putting aside the question of prior publication, and the effective dates of such publication, and the argument that a typewritten manuscript deposited and indexed in the library of a major university is not a "printed publication" under Sec. 102(b), we find a more compelling reason to consider these items.

While we can accept Shepardson's testimony that he was unaware of the publications in the newspapers, the *Erie Times-News* and *The Grape Belt,* it is impossible to escape the conclusion that the failure to disclose the other publications which he authored, or the research theses which he supervised, to the Patent Office as part of the pertinent prior art is sufficient to render all of the claims invalid, even though some might otherwise be valid.

35 U.S.C. § 253 and § 288 preserve valid claims, despite the invalidity of other claims, if the invalid claims were made without "deceptive intention". "Deceptive intention" is more than mere technical fraud, as might be revealed by a finding of obviousness, and requires actual fraud or other inequitable conduct. *Walker Process Equip. Inc. v. Food Machinery & Chem. Corp.,* 382 U.S. 172 [1965]; *Kearney & Trecker Corp. v. Giddings & Lewis, Inc.,* 452 F. 2d 579 [7th Cir. 1971].

Shepardson was a co-author of all of the printed articles appearing in the technical journals. He knew of their publication. Each publication contained a bibliographical reference to prior publications on the subject. He supervised the graduate students who reported on his research in master's theses deposited in the Cornell Library system. The titles of the publications *"Grape Harvesting Research at Cornell"; "Grape Harvesting Research at Cornell-II; "Mechanical Grape Harvesting"*, and the indexed titles of the theses all contain a clear reference to the subject matter of the patent application.

In *Strong v. General Electric Co.,* 434 F. 2d 1042 [5th Cir. 1970], the court rejected the argument under Sections 253 and 288 that some claims may stand even though others are invalid, by stating:

"[T]hose sections apply to invalid claims which are made inadvertently or by mistake and which are promptly disclaimed." (p. 1046).

"The court also finds that the *Electrical South* publication was published with Mr. Strong's knowledge, if not at his request, so that his failure to include that publication as part of the prior art to be considered by the patent office invalidates all claims in the patent even if some of those claims otherwise would have been patentable." (p. 1045).

In *Strong* the printed description did not mention certain of the elements described in one of the claims, and the court held that it could not assume they were included in the publication. However, the court did find that the description was sufficiently clear to enable one reasonably skilled in the art to reproduce it and that the product so produced would have been the same meter box for which the patent was issued in 1961.

In *Monsanto Company v. Rohm & Haas*, 456 F. 2d 592 [3rd Cir. 1972] the court of appeals held a patent invalid for failure to disclose based on the failure to disclose the full extent of the experimental work of the applicant. The patent in question in that case was the result of a third application, after two prior rejections. The third application was initially rejected by the Patent Office as obvious under the prior art until the applicant submitted an affidavit based on certain test results, which showed less than 25% of the tests conducted. The Court of Appeals found that:

"[C]oncealment and non-disclosure may be 'evidence of and equivalent to a false representation, because the concealment or suppression is, in effect, a representation that what is disclosed is the whole truth'. *Stewart v. Wyoming Cattle Ranch Co.*, 128 U.S. 383, 388-89". 456 F. 2d at p. 599.

The Court of Appeals cited the doctrine laid down in *Precision Co. v. Automotive Company*, 324 U. S. 806, 816 that "the circumstances surrounding the application for the patent to be free from fraud or other inequitable conduct".

The Court of Appeals found that the inventor's success in gaining a patent on his third application, originally rejected by the examiner and later accepted after the presentation of the test reports, was attributable to the fact that the report of tests submitted "permits, if not compels, the misleading inference that it constituted an accurate analysis of all the testing instead of the edited version thereof."

In the case at bar we have the testimony of Patent Examiner Stone, who examined the Shepardson application, that he would not have permitted the claims of the Shepardson application to issue in the form that he did if he had been aware of the *Studer* thesis, the *Padget* thesis, the *Grape Belt* article, and the *Erie-Times News* article. Stone further testified that he would have considered the *Studer* thesis to be a reference as of the date appearing on the cover page of the thesis.

After this lawsuit was initiated, Plaintiffs disclaimed several of the claims of this patent. It appears that the claims disclaimed would have been those disclosed by the *Agricultural Engineering* article of February 1962 or the *Studer* thesis of 1962. These publications did not appear before the parent application but they did appear prior to the CIP application and discloses matters contained in the CIP application.

In *Strong v. General Electric*, cite *supra*, the requirements for the application of Sections 253 and 288 are that the invalid claims which do not render all claims invalid must be those "made inadvertently or by mistake and which are promptly disclaimed."

This undisclosed prior art would have been brought to the attention of the applicant during the pendency of the ap-

plication when he filed an affidavit in the interference proceeding identical in content to the paper published in the bound volume of the 1960 *Proceedings* of the New York State Horticultural Society.

We do not find the failure to disclose such an important body of prior art authored or supervised by the inventor to be inadvertent. Likewise, the long history of the present patent, and the interference contest raised, does not make a disclaimer filed after litigation commenced, a "prompt disclaimer" in our opinion.

There has been no testimony from the inventor as to why these pieces of pertinent prior art were not brought to the attention of the Patent Office.

We, therefore, conclude that the failure to disclose the prior art was deliberate on the part of the applicant, that the undisclosed prior art was *material,* and that the Patent Office was in fact *misled* by the failure to disclose, and that the disclaimer of the invalid claims were not promptly made.

We, therefore, find from the evidence that defendant has met its burden of proof; the presumption of validity of the patent in question has fallen because of failure of the Patent Office to consider the pertinent prior art; that all claims except Claims 14 and 15 are invalid by reason of prior publication under Sec. 102(b), or obvious in the light of the prior art under Sec. 103 of Title 35 U.S.C.

We also find that Defendant has met its burden of proving by clear and convincing evidence that all remaining claims of the patent in question, not invalid by virtue of prior publication or obviousness in the light of the prior art, are invalid by reason of deliberate failure of the applicant to disclose pertinent prior art, which non-disclosure was

material and did in fact mislead the Patent Office in its approval of the application in question.

Order.

AND NOW, this 17th day of July, 1975, upon this matter heard by the court, and upon consideration of the evidence, and arguments and briefs of counsel, it is

ORDERED that Judgment be and hereby is Entered for Defendants and against Plaintiffs, and that United States Patent 3,380,236, issued April 30, 1968, to Edwin Stanley Shepardson be hereby declared Invalid. Each party to bear its own costs.

The foregoing Opinion shall constitute the findings of fact and conclusions of law in the within case.

GERALD J. WEBER,
United States District Judge.

cc:

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Order Correcting Opinion of the United States District Court

(Filed August 18, 1975.)

IN THE UNITED STATES DISTRICT COURT
For the Western District of Pennsylvania

CHISHOLM-RYDER COMPANY, INC., a corporation, and NEW YORK STATE CONCORD GRAPE PRODUCTION RESEARCH FUND, INC., a corporation,

Plaintiffs,

vs.

LEWIS MANUFACTURING COMPANY, INC. a corporation, and LEO J. LEWIS, an individual, and WILLIAM J. LEWIS, an individual, and LEWIS MANUFACTURING COMPANY, a partnership,

Defendants.

Civil Action 47-69 ERIE.

It is hereby ORDERED that the opinion in the above case filed July 17, 1975 be corrected as follows:

Page 21, The second paragraph, including the indented quotation, should be corrected to read as follows:

• • •

Appendix to Petition—Order Correcting Opinion of the United States District Court.

"Our examination of the *Grape Belt* article does not reveal the teaching of the upper portion of the wall of the trough nor do we find reference to it in the 1961 *Proceedings* of the New York State Horticultural Society. A reference to the problem appears in the article in *Agricultural Engineering,* February, 1962 issue by the inventor and his colleagues (Studer, Shaulis and Moyer) in that on page 68, column 1 of said article, the following description appears:

> 'The outer wing (and its nose piece) must be flexible so that it can yield, when vine and post obstructions are hit, and then return to its initial position.'

The photograph of the 1961 experimental model appearing as figure 2 on page 67 of the *Agricultural Engineering* article shows a view of the outer wall but does not show it arranged in upper and lower portions so that the trunks of the vines can pass between them."

• • •

ORDERED filed this 18th day of August, 1975.

GERALD J. WEBER,
United States District Judge.

cc: all counsel.

Memorandum Opinion and Order of the United States District Court

(Filed March 31, 1976.)

IN THE UNITED STATES DISTRICT COURT
For the Western District of Pennsylvania

CHISHOLM-RYDER COMPANY, INC.,
a corporation et al,
Plaintiffs,

v.

LEWIS MANUFACTURING COMPANY, INC.,
a corporation et al,
Defendants.

Civil Action No. 47-69 ERIE.

Plaintiff's Motion to Alter Judgment is addressed to our findings of invalidity of claims 12, 14 and 15 of the patent in suit.

Claim 12 involves the division of the wall on the trunk side of the gathering and transporting means into upper and lower portions.

Claim 14 involves a freely rotatable hub with arms projecting radially, the arms of said hub being at an acute included angle to the verticle so that in moving along the vines the arms are brought into contact with the longitudinal trellis wire.

Claim 15 is that the acute included angle of the axis of the hub is on the order of 30°.

Our findings that claims 1, 2, 5, 6, 8, 11 and 17 are invalidated by reason of prior publication are not contested.

Our original finding that claim 12 was invalid by the prior publication in *Agricultural Engineering*, February, 1962, is withdrawn based on our correction of the quotation from that publication in our "Order Correcting Opinion," of August 18, 1975.

Appendix to Petition—Memorandum Opinion and Order of the United States District Court.

We reaffirm our finding on P. 22 of the opinion of July 17, 1975, that matters revealed in Claim 12 are obvious and thus invalid in view of the prior art.

We held all of the claims invalid because of the failure of the applicant to disclose to the patent office the prior art of which he was aware.

Plaintiffs' objection is that the court misapprehended the inventor's duty to disclose by wrongfully imputing to him knowledge of matters of prior art of which he was actually unaware and in failing to appreciate the lack of materiality of that prior art of which he had actual notice.

Plaintiffs suggest a four part test of each item of the prior art to determine plaintiffs' duty to disclose to the patent office. The first test is the inventor's knowledge of the item.

Each of the items that we considered in our opinion originated from the inventor. The January, 1960, paper delivered to the New York State Horticultural Society was authored by the inventor, and was read from a typewritten text. The papers read at the proceedings are published in an annual volume. The identical text, without photographs or bibliography, appears in the *Grape Belt* periodical on March 3, 1960.

The January, 1961, paper read by the inventor at the New York State Horticultural Society was also published, as is the regular procedure, in the annual report.

The article in the February, 1962, issue of *Agricultural Engineering*, with photographs and diagrams, was prepared by the inventor, with others, including Studer, and refers to the Studer thesis, expected to be published in June of 1962.

Shepardson, the inventor, supervised both Studer and Padget in the preparation of their graduate theses which would be deposited in the Cornell University Library.

We cannot escape the conclusion that the inventor was aware of the dissemination of knowledge of his invention.

Do these items have the character defined in 35 U.S.C. 102 (a) as

> "known or used by others in this country, . . . or described in a printed publication in this . . . country, before the invention thereof,"

or subsection (b) of the same section:

> "described in a printed publication . . . more than one year prior to the date of the application. . . ."

The parent application was filed on March 30, 1961. By that time the 1960 Proceedings, the *Grape Belt* article and the Padget thesis had all been published. None of these were cited to the Patent Office.

The Continuation in Part application was filed April 16, 1965, and by that time the *Agricultural Engineering* article and the 1961 Proceedings had been published and the Studer thesis had been filed. These were not cited to the patent office.

Are these material to the claims which the inventor made?

We have previously found that all these publications reveal all of the claims of the patent except claims 12, 14 and 15. We have also held that Claim 12 was obvious. Only claims 14 and 15 were not clearly identified in prior publications.

We may note, in support of our findings, that Plaintiffs disclaimed Claims 3, 4, 7, 9, 10, 13, 16 and 18 after this suit was filed. In light of the publication of the *Agricultural Engineering* article, which was not disclosed to the Patent Office, it appears that the inventor claimed more than that to which he was entitled, in view of the statutory bar presented by the *Agricultural Engineering* publication.

The inventor was aware of the *Agricultural Engineering* article before the C.I.P. application in 1965 and failed to disclose this.

In *Chromalloy American Corp v. Alloy Surfaces Co., Inc.*, 339 F. Supp. 859 (D. Del. 1973) the court held:

> "The Court finds that the failure to disclose the highly material information during the prosecution of the C.I.P. application, which, if disclosed, would have rendered Claims 9 to 14 invalid, amounted to intentional concealment which permeated all of the interrelated claims of the patent, including Claims 1 to 8 originally allowed in the parent application and allowed in the C.I.P. This, thereby, renders all of the claims of '230 Patent unenforceable." 339 F. Supp. at 876.

We have previously cited the holding of *Strong v. General Electric Co.*, 305 F. Supp. 1084, aff'd 434 F.2d 1042 (5th Cir. 1970) as to the effect of failure to reveal a publication as part of the prior art in invalidating all claims, even if some of those claims would otherwise have been patentable.

The plaintiffs complain that the court adopted the "melded" disclosures of the prior art instead of considering them individually. We did this because the inventor either authored, co-authored or supervised the publication of all of the elements of prior art that we examined, and we had found that none of them were disclosed to the Patent office. It is striking to compare the prior art cited by the Patent Office, *i.e.* the Lamoura patent and the Tubbs patent, with the undisclosed material. The undisclosed material is far more relevant to the claims in question than either patent cited.

As stated in *In Re Multidistrict Litigation Involving Frost Patent*, 185 U.S.P.Q. 729, 745 (D. Del. 1975)

"coupling the fact of the nondisclosure with the fact that General knew or should have known that the undisclosed information in its possession could have refuted the arguments it was making to the Patent Office, this court is warranted in drawing an inference of fraudulent intent."

We therefore affirm our finding that the nondisclosure was material and did mislead the Patent Office in its approval of the application in question. Therefore, we find that Claims 15 (14?) and 15 are invalid without a separate determination of patentability.

Order

IN THE UNITED STATES DISTRICT COURT
For the Western District of Pennsylvania

CHISHOLM-RYDER COMPANY, INC.,
a corporation et al,

Plaintiffs,

vs.

LEWIS MANUFACTURING COMPANY, INC.,
a corporation et al,

Defendants.

Civil Action No. 47-69 ERIE.

And now, this 30th day of March, 1976, upon consideration of Plaintiffs' Motion to Amend Judgment, the same is ordered DENIED.

GERALD J. WEBER,
United States District Judge.

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Kenneth R. Sommer, Esq.,
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Appendix to Petition—Memorandum Opinion and Order of the United States District Court.

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Judgment Order of the Court of Appeals

UNITED STATES COURT OF APPEALS
For The Third Circuit

NO. 76-1708

CHISHOLM-RYDER COMPANY, INC., a corporation, and NEW YORK STATE CONCORD GRAPE PRODUCTION RESEARCH FUND, INC., a corporation,
Appellants,

vs.

LEWIS MANUFACTURING COMPANY, a corporation and LEO J. LEWIS, an individual, and MARK LEWIS, an individual, and WILLIAM L. LEWIS, an individual, and LEWIS MANUFACTURING COMPANY, a partnership,
Appellees.

(D.C. Civil Action No. 74-69)

Appeal From the United States District Court for the Western District of Pennsylvania

---

Argued January 13, 1977

Before: GIBBONS and GARTH, *Circuit Judges*,
BECHTLE*, *District Judge*.

Appendix to Petition—Judgment Order of the Court of Appeals.

William J. Kelly, Esquire, Elderkin, Martin, Kelly, Messina & Zamboldi, Eighth Floor, Commerce Building, Erie, Pennsylvania 16501; Kenneth R. Sommer, Esquire, Peter K. Sommer, Esquire, Sommer & Sommer, 1022 Ellicott Square, Buffalo, New York 14203, Attorneys for Appellants.

Charles L. Lovercheck, Esquire, 1315 G. Daniel Baldwin Building, Erie, Pennsylvania 16501; Wayne L. Lovercheck, Esquire, 2742 Hampton Parkway, Evanston, Illinois 60201, Attorneys for Appellees.

The findings of fact of the district court are not clearly erroneous and the court applied correct legal standards.

It is ORDERED and ADJUDGED that the judgment of the district court is affirmed. Costs to be taxed in favor of appellees.

By the Court,

JOHN GIBBONS,
Circuit Judge.

Attest
THOMAS F. QUINN,
Clerk.

Dated: Jan 17 1977.

---

* Louis C. Bechtle, United States District Court for the Eastern District of Pennsylvania, sitting by designation.

Order of the Court of Appeals

UNITED STATES COURT OF APPEALS
For The Third Circuit

No. 76-1708

CHISHOLM-RYDER COMPANY, INC., a corporation, and NEW YORK STATE CONCORD GRAPE PRODUCTION RESEARCH FUND, INC., a corporation,

Appellants,

vs.

LEWIS MANUFACTURING COMPANY, a corporation and LEO J. LEWIS, an individual, and MARK LEWIS, an individual, and WILLIAM L. LEWIS, an individual, and LEWIS MANUFACTURING COMPANY, a partnership,

Appellees.

(D.C. Civil Action No. 74-69)

SUR PETITION FOR REHEARING

Present: SEITZ, *Chief Judge,* VAN DUSEN, ALDISERT, ADAMS, GIBBONS, ROSENN, HUNTER, WEIS and GARTH, *Circuit Judges.*

The petition for rehearing filed by Appellants in the above entitled case having been submitted to the judges who par-

ticipated in the decision of this court and to all the other available circuit judges of the circuit in regular active service, and no judge who concurred in the decision having asked for rehearing, and a majority of the circuit judges of the circuit in regular active service not having voted for rehearing by the court in banc, the petition for rehearing is denied.

By the Court,

JOHN GIBBONS,
Judge.

Dated: February 24, 1977.

Supreme Court, U. S.
FILED
JUN 15 1977
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1976

No. 76-1628

CHISHOLM-RYDER COMPANY, INC., and
NEW YORK STATE GRAPE PRODUCTION
RESEARCH FUND, INC.,
Petitioners,

vs.

LEWIS MANUFACTURING COMPANY, LEO J.
LEWIS, WILLIAM L. LEWIS, MARK LEWIS and
LEWIS MANUFACTURING COMPANY,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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Statutes Involved

35 USC 102 (b) "CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT

"A person shall be entitled to a patent unless—

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States."

35 USC 103 "CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

28 USC 2111 "HARMLESS ERROR

"On the hearing of any appeal or writ of certiorari in any case, the court shall give judgment after an examination of the record without regard to errors or defects which do not affect the substantial rights of the parties."

FRCP RULE 61 "HARMLESS ERROR

"No error in either the admission or the exclusion of evidence and no error or defect in any ruling or order or in anything done or omitted by the Court or by any of the parties is ground for granting a new trial or for setting aside a verdict or for vacating, modifying, or otherwise disturbing a judgment or order, unless refusal to take

such action appears to the court inconsistent with substantial justice. The court at every stage of the proceeding must disregard any error or defect in the proceeding which does not affect the substantial rights of the parties."

Statement of the Case

The Patent in suit was issued to Professor Shepardson on April 30, 1968. A parent patent application was filed on March 30, 1961, which was refiled with new matter as a Continuation-In-Part (CIP) application on April 16, 1965 (Appendix to Petition 2a).

The eighteen claims of the Shepardson patent No. 3,380,236 can be divided into four groups:

Group A (Claims 3, 4, 7, 9, 10, 13, 16, 18) were disclaimed subsequent to the filing of the suit but prior to the trial thereon (2a). They were not part of the patent at trial, and no testimony was taken on them.

Group B (Claims 1, 2, 5, 6, 8, 11, 17) were held invalid under Title 35 USC 102 (b) and 103 because of the Grape Belt article, of which the inventor may have been unaware although he was a co-author of the text (27a). This part of the ruling was not appealed by Petitioners.

Group C (Claim 12) covered new matter added by the CIP application (7a). The Courts below held Claim 12 obvious and thus invalid under Title 35 USC 103 (35a). Petitioners appealed as to this part of the ruling. The ruling was affirmed by the Third Circuit Court of Appeals (42a).

Group D (Claims 14, 15) covered new matter added in the CIP application (7a). The Courts below held Group D invalid because of the deliberate non-disclosure of material prior art

known to the inventor which mislead the Patent and Trademark Office (38a). Petitioners appealed as to this part of the ruling. The ruling was affirmed by the Third Circuit Court of Appeals (42a).

The District Court held that Claims 14 and 15 (Group D) were invalid because Professor Shepardson deliberately failed to disclose to the Patent and Trademark Office five pertinent prior art publications (27a, 30a, 38a).

Each item of withheld prior art, all of which were co-authored or supervised by Shepardson, was far more relevant to the subject matter of the application than the prior art known to the Patent and Trademark Office (37a).

The inventor has never explained why this pertinent prior art was not disclosed to the Patent and Trademark Office (30a).

The undisclosed prior art included the following items:

The *Padget Thesis*, dated June, 1959, was written by John Richard Padget under the supervision of Shepardson. It described a mechanical grape harvester with a vertical axis vibrator which employed a clamp to engage the trellis wire (10a).

The *105th Proceedings*, a publication which contained a paper co-authored and read by Shepardson at the 105th Annual Meeting of the New York State Horticultural Society of January 19, 1960. The paper was later published in the 105th Proceedings. This article was identical in text to the Grape Belt newspaper article of March 8, 1960 (15a, 16a), and Shepardson submitted the same text to the United States Patent Office as the first disclosure of his invention in an interference proceeding (29a-30a). It describes a mechanical grape harvester with a vertical axis vibrator and a spiked wheel to engage the trellis wire (9a-10a, 16a-17a).

The *106th Proceedings*, a publication which contained a paper co-authored and read by Shepardson at the 106th Annual Meeting of the New York State Horticultural Society of January 17, 1961. The paper was later published in the 106th Proceedings. The article described a mechanical grape harvester with a vertical axis vibrator and a spiked wheel to engage the trellis wire (10a).

The *Agricultural Engineering* magazine dated February, 1962, contained an article co-authored by Shepardson, which described a mechanical grape harvester with a vibrator with an axis tilted downward and rearward and a spiked wheel to engage the trellis wire (10a) which is the subject of Claim 14.

The *Studer Thesis*, dated February, 1962, was written by Henry Eugene Studer under the supervision of Shepardson, and described a mechanical grape harvester having a vibrator with an axis tilted downward and rearward and with a spiked wheel to engage the trellis wire (11a).

The patent in suit involves a mechanical grape harvester with a vibrator having an axis tilted downward toward the trellis wire and rearward, and having a spiked wheel to engage the trellis wire (3a-5a).

The District Court invalidated eight of the ten retained claims on the ground of prior publications (35 USC 102(b)) or obviousness in view of prior publications (35 USC 103). The remaining two claims were held invalid on the ground of fraud on the Patent Office in view of the deliberate withholding of five pertinent prior art references from the Patent Office by the inventor (30a-31a).

The Court of Appeals affirmed the opinion of the District Court without comment and denied a petition for rehearing *in banc*.

ARGUMENT

No Justiciable Issue Raised

None of the questions raised in the Petition presents a justiciable issue for the Court to decide. It is well settled that the United States Supreme Court will not decide a case, unless there exists a definite and concrete controversy touching the legal relations of the parties having adverse legal interests. Aetna Life Insurance Co. of Hartford, Connecticut v. Haworth (1937) 300 U.S. 227, 240-241.

Further, the harmless error doctrine, as expressed in Federal Rules of Civil Procedure, Rule 61 and Title 28 USC 2111 is that the Court at every stage of the proceeding must disregard any error or defect in the proceeding which does not affect the substantial rights of the parties. Errors which are technical and of no consequences to the fundamental rights of the parties must be disregarded. If there is no controversy as to rights, which may be substantially affected by error, no reversible error can arise. Southern Talow Co. v. David J. Joseph and Co. (CCA 5th 1939) 101 F. 2nd 862.

Thus, the Supreme Court will not disturb a judgment unless there both exists a concrete controversy between parties with adverse legal interests and an error was made which affected the substantial rights of the parties.

It is submitted that the questions presented do not raise a concrete controversy between the parties and that the errors alleged, if they are errors, are harmless and will not affect the decision of the case at bar.

I. 35 USC 253 and 288 were not relied on in the holding of fraud on the Patent and Trademark Office

Contrary to Petitioner's statements, the Courts below did not apply 35 USC 253 and 288 in its holding that Claims 14

and 15 were invalid. Nor did the Courts below apply these sections to hold invalid any of the claims not disclaimed by the Petitioner. The Courts referred to the disclaimer and its timing only as another fact that tended to indicate that the Petitioner was attempting to secure something to which he was not entitled (36a).

The holding that the Claims 14 and 15 are invalid would remain unchanged regardless of whether or not this Court would find that 35 USC 253 and 288 requires that a disclaimer be filed promptly. Likewise, the holding would remain unchanged whether or not this Court would find that the mere filing of a disclaimer under 35 USC 253 and 288 permits a court to infer that the disclaimed claims were invalid.

The District Court, affirmed by the Appellate Court, held all claims invalid, even though some of the claims were otherwise valid, because of the failure of the inventor to disclose pertinent prior art to the Patent and Trademark Office (27a).

The Courts below then went on to discuss 35 USC 253 and 288. These remarks were in the nature of *Obiter Dictum*. They were made by the judge in pronouncing an opinion on a cause, concerning some rule, principle or application of law, or the solution of a question suggested by the case at bar, but not necessarily involved in the case or essential to its determination. State *ex rel.* Lemon v. Langlie, as Governor, 273 P. 2d 464 (1954).

In the opinion of the United States District Court dated July 17, 1975, at page 30a, the Court made a finding that the failure to disclose the prior art, which was authored or supervised by the inventor, was not inadvertent.

The Court then commented that the inventor has offered no reason why this pertinent prior art was not disclosed to the Patent and Trademark Office before stating several separate conclusions:

1) that the applicant deliberately failed to disclose the prior art;

2) that the undisclosed prior art was material;

3) that the Patent and Trademark Office was misled by the failure to disclose; and

4) that the disclaimer was not promptly made.

The Court then found all claims, except 14 and 15, invalid by reason of prior publication (35 USC 102 (b)) or obviousness (35 USC 103), and found all claims, not otherwise invalid, invalid by reason of the deliberate failure of the applicant to disclose pertinent prior art, which non-disclosure was material and, in fact, misled the Patent and Trademark Office.

Further support for the position that 35 USC 253 and 288 were not relied upon in the Court's finding of fraud is found at Page 27a of the opinion were the Court concluded that the failure to disclose the publications, which he authored, or the theses, which he supervised, was sufficient to render all of the claims invalid.

The conclusions of fraud was reached before the Court undertook a discussion of the possible effect of 35 USC 253 and 288 on the case.

Further support for this position is found in the Court's Memorandum Opinion of March 31, 1976 (34a) which does not even refer to the statute, although the fact of the disclaimer being made was mentioned (36a) in support of the findings of the Court.

A fair reading of the Opinions of the Court below would be that it did not consider 35 USC 253 and 288 to be controlling in its decision, and it did not rely on these sections in its finding of fraud on the Patent and Trademark Office.

II. Deliberate concealment of prior art from the Patent and Trademark Office can reasonably be inferred from the facts found by the Court below

The Courts below reasonably found that Shepardson deliberately concealed the prior art from the Patent and Trademark Office from the facts it found in the case.

The Courts found deliberate concealment by Shepardson of prior art based on much more than the facts that he had knowledge of such prior art. First of all, there was the volume of this prior art, five separate and complete prior art references. The Courts also found that Shepardson had a duty to disclose pertinent prior art to the Patent and Trademark Office (37a).

The Courts further found that each of the undisclosed prior art references was more material than any of the art known to the Patent and Trademark Office (37a), and that Shepardson, who either co-authored or supervised all of the undisclosed references, knew of the references and knew that they were pertinent (25a-26a).

The Courts also found that Shepardson, throughout the long history of the prosecution of the application, never disclosed these prior art references to the Patent and Trademark Office; and that Shepardson has never offered any explanation as to why these references were not disclosed (30a).

The Courts also noted that Shepardson made no effort to disclaim any claims of his patent throughout the long pendency of the application, during the interference proceeding and until a year after this suit was filed and the prior art references were discovered (29a).

On the basis of these facts, the Court below properly found that all of the claims were invalid (27a, 30a) because Shepardson deliberately concealed pertinent prior art from the Patent and Trademark Office.

The Court below properly held invalid all of the claims of Petitioners' patent in suit under the law and the facts of the case. Substantial justice has been done between the parties. There is no substantial issue raised to warrant granting this Petition for a Writ of Certiorari.

Conclusion

Respondents respectfully request that this Petition for a Writ of Certiorari be denied.

Respectfully,

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Supreme Court, U. S.
FILED
JUN 28 1977
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1976

No. 76-1628

CHISHOLM-RYDER COMPANY, INC., and NEW YORK STATE GRAPE PRODUCTION RESEARCH FUND, INC.,

Petitioners,

vs.

LEWIS MANUFACTURING COMPANY, LEO J. LEWIS, WILLIAM L. LEWIS, MARK LEWIS and LEWIS MANUFACTURING COMPANY,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

PETITIONERS' REPLY MEMORANDUM

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IN THE

Supreme Court of the United States

October Term, 1976
No. 76-1628

CHISHOLM-RYDER COMPANY, INC., and NEW YORK STATE GRAPE PRODUCTION RESEARCH FUND, INC.,

Petitioners,

vs.

LEWIS MANUFACTURING COMPANY, LEO J. LEWIS, WILLIAM L. LEWIS, MARK LEWIS and LEWIS MANUFACTURING COMPANY,

Respondents.

On Petition For Writ of Certiorari to the United States Court of Appeals for the Third Circuit

PETITIONERS' REPLY MEMORANDUM

In Respondents' Brief in opposition to the petition for writ of certiorari, factors are advanced to justify as reasonable the lower Courts' critical inference that Shepardson's failure to disclose five items of prior art to the Patent and Trademark Office was "deliberate". These factors will be considered hereinafter under separate headings.

Factor Of Disclaimer Aspects

According to the Courts below, the failure of Shepardson to file a disclaimer promptly, waiting until after this lawsuit was commenced to do so, and the inference made by the Courts that filing a disclaimer is an admission that Shepardson claimed more than that to which he was entitled, necessarily involved the Courts' application of 35 U.S.C. §§ 253 and 288, and, moreover, are factors which Respondents contend contribute to rendering reasonable the inference made by the Courts below that Shepardson deliberately failed to disclose prior art to the Office.

Thus, Respondents' presented Question 2 answers their presented Question 1 affirmatively, as well as involves Petitioners' presented Questions 1 and 2, and obviously encompasses Petitioners' presented Question 3.

Since there is no requirement for a "prompt" filing of a disclaimer, as there was under the old law, the time when a disclaimer is filed has no probative value in inferring a deceitful intent.

The rationale behind the principle that the filing of a disclaimer is not an admission by the patentee that the disclaimed matter was not patentable, is clearly explained in *Permutit Co. v. Wadham*, 13 F.2d 454, 457 (6th Cir. 1926):

> "We do not understand that a disclaimer to avoid the supposed anticipating or limiting effect of some other publication is a confession that the patent would be void if the disclaimer were not made. The patentee decides a question of policy; he may think that, although the supposed anticipation can be successfully met and defeated, a disclaimer will not affect the real value of his patent, and to make it will save trouble and expense and do no harm. We see no reason why he is not at liberty, after the disclaimer as before, to deny the anticipatory effect of the other matter; and it has been so held (citing case)."

Accordingly, there is no probative value to be derived from the mere fact of filing a disclaimer, for inferring a deceitful intent.

Factor of Volume Of Non-Disclosed Prior Art

Respondents point to the volume of the non-disclosed prior art as another factor for support of the lower Courts' inference of deliberate concealment. Involved are publications (*105th Proc., 106th Proc., Ag. Eng.*) of three articles which Shepardson co-authored, and two theses (*Padget, Studer*) of graduate students whom he supervised. Assuming these five items to be "printed publications" within the meaning of 35 U.S.C. § 102, and further assuming they were proven up as to date, which they were not, they could only be potential prior art against claims supported on the continuation-in-part application and not against those claims supported on the parent application.[1] The Courts below found that the subject matter of claims 12, 14 and 15, those appealed by Petitioners, was not disclosed in the parent application and thus was subject to prior art dated more than one year (April 16, 1964) prior to the filing date of the continuation-in-part application, whereas the remaining claims (1, 2, 5, 6, 8, 11 and 17) were supported by the disclosure of the parent application.

It is again emphasized at this juncture that the seven claims 1, 2, 5, 6, 8, 11 and 17 were invalidated on the *Grape Belt* newspaper article, not one of the non-disclosed five items of which Shepardson had chargeable knowledge. While *Grape Belt* included the same text of the manuscript which Shepard-

[1] The exception could be *Padget*, but its disclosure is so remote to the patent claims as to be grossly immaterial.

son co-authored, as was later published in *105th Proc.*, the latter was not published early enough to be prior art against the parent application, whereas *Grape Belt* was, although the manuscript was caused to be published unintentionally in *Grape Belt* by one of Shepardson's co-authors and without Shepardson's knowledge. The Courts below expressly found that Shepardson was unaware of the *Grape Belt* publication, so that he cannot be faulted for not bringing this newspaper article to the attention of the Office. *Layne-New York Co., Inc. v. Allied Asphalt Co., Inc.*, 363 F.Supp. 299, 307 (W.D. Pa. 1973), rev'd. on other grounds, 501 F.2d 405 (3rd Cir. 1974), cert. denied, 421 U.S. 914 (1975).

Notwithstanding the five non-disclosed items could only be potential prior art against claims 12, 14 and 15, the Courts below found that claims 14 and 15 were patentable over all of the prior art items advanced by Respondents, including the five non-disclosed items; and that claim 12 was unpatentable because considered obvious over *Ag. Eng.* and *Studer*, but the Courts went on to state that deceptive intention involved more than mere technical fraud, as might be revealed by a finding of obviousness.

Adverting to Respondents' point of the volume of the non-disclosed prior art contributing to the alleged reasonableness of the lower Court's inference of deliberate concealment, it is seen that the quality rather than the quantity of such prior art is the important thing. The significance of prior art lies not in its volume, but in its content insofar as its capability to anticipate the subject matter of a claim. Thus, the mere volume of prior art has no probative value.

Factor of Non-Disclosed Prior Art Being "Pertinent"

Another contention advanced by Respondents as contributing to the alleged reasonableness of the lower Courts' inference of deliberate concealment, is that the Courts below found that Shepardson had a duty to disclose "pertinent" prior art to the Office. The Courts did not explicitly so state. If a duty to disclose merely "pertinent" prior art is implied from the Courts' statements, it is clearly erroneous.

The non-disclosed prior art items do pertain generally to mechanical grape harvesting and therefore are "pertinent", or relate generally to such harvesting and therefore are "relevant", but this is not tantamount to disentitling the patentee to the claims for which he was asking. It is the effect on the patentee's entitlement to the allowability of a patent claim, that counts. By the lower Courts' own analysis, Shepardson was not disentitled to claims 14 and 15, and was only disentitled to claim 12 because its subject matter was considered obvious, but this was not regarded as seeking such claim 12 fraudulently or as a result of inequitable conduct.

An applicant has no duty to disclose to the Office prior art which he is aware of which is merely "pertinent" or "relevant", but not "material". Even if "material", the applicant has not breached his duty unless the prior art was withheld with a deceitful intent designed to obtain a claim to which he clearly would not otherwise have been entitled.

The lower Courts cited no authority for the principle, urged by Respondents, that a patentee has a duty to disclose merely "pertinent", or "relevant", prior art to the Office.

Factor of Non-Disclosed Prior Art Allegedly Being More "Material"

Respondents further contend that the non-disclosed prior art was more "material" than any cited by the Office. The Courts below did not say that; they said more "relevant". Neither did the Courts state that Shepardson knew these non-disclosed prior art items were more "pertinent", as Respondents contend.

Before adopting its final statement of a duty to disclose information which is "material" to the examination of a patent application, as set forth in 37 C.F.R. 1.56(a), the Patent and Trademark Office substituted "material" for "relevant" so as to connote something more than a trivial relationship. Its definition of "material", also incorporated in 37 C.F.R. 1.56(a), states: "Such information is material where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent." The Office stated (955 O.G. Pat. Off. 1055-1056) it was guided substantially by this Court's articulation of "materiality" in an analogous context, specifically securities law instead of patent law, in *TSC Industries, Inc. v. Northway, Inc.*, 426 U.S. 438 (1976). There, this Court noted (426 U.S. at 448-449) that the standard of materiality should not be so low that persons would be "subjected to liability for insignificant omissions or misstatements," or so low that the fear of liability would cause management "simply to bury the shareholder in an avalanche of trival information—a result that is hardly conducive to informed decision making."

Similar concerns were prophesied in a patent context regarding the duty to disclose known prior art to the Office.

In *United States v. Standard Electric Time Co.*, 155 F.Supp. 949 (D. Mass. 1957), appeal dismissed, 254 F.2d 598 (1st Cir.

1958), the government brought suit to cancel a patent on the grounds of fraud and mutual mistake, alleging that the patentee, an assistant professor at M.I.T., had failed to disclose to the Patent Office four published masters theses on deposit in the M.I.T. library and of which he had actual knowledge. None of the theses was an "anticipation" in the 35 U.S.C. § 102 sense of disclosing each and every feature of the claims which the applicant had sought. With respect to the patentee's duty to disclose these four theses to the Patent Office, the court said:

> "The applicant's obligation under 35 U.S.C. § 115 and under former Rule 46 was to state whether to the best of his knowledge and belief the invention has been described in any printed publication. Of course, a putative inventor must disclose any printed publication which he either knows or believes describes the very invention claimed. United States v. American Bell Telephone Co., 128 U.S. 315, 355-356, 9 S.Ct. 90, 32 L.Ed. 450. More than this, if he knows of a printed publication which plainly describes his claimed invention, or comes so close thereto that every reasonable man would say the invention claimed was not original but had been anticipated, then regardless of his personal view that he is the original inventor, he will not be excused for his failure to disclose his knowledge. But the applicant has no duty to cite every publication of which he knows, or which he had used, merely because the publication is one likely to be referred to by a vigilant examiner in the Patent Office, or by a rival in an interference or other proceeding. It is not the object of the quoted statute or rule to supply all available evidence to the Patent Office, or to force the applicant to set up what he regards in good faith as straw men which he reasonably and in good faith believes he can knock down." 155 F.Supp. at 952.

To the same general effect is the following statement in *Becton, Dickinson & Co. v. Sherwood Medical Industries*, 516 F.2d 514, 524 (5th Cir. 1975):

> "Fair dealing—is not a mechanical mandate that every patent ultimately cited by the Examiner in issuing the patent or, more so, by the unlimited industry of counsel in a years-later infringement suit in which every writing, periodical, or patent, foreign or domestic, is dredged up as prior art, must be cited in the application. It is again a matter of judgment in the light of accepted practices by and with the Patent Office in using good, not bad, faith in citing art thought to be of sufficient relevance."

Were the duty to disclose otherwise, the result would have:

> "... the harmful effect of forcing a patent solicitor to flood the Patent Office in each case with a mass of data of doubtful materiality rather than take the risk that an inventor might later be denied the fruits of his monopoly because of failure to reveal some fact later magnified out of proportion by an infringer seeking to escape the reach of the patent by combing the inventor's files under our liberal pre-trial discovery procedures and dredging up some new found 'facts'." *Xerox Corp. v. Dennison Mfg. Co.*, 322 F.Supp. 964, 968 (S.D.N.Y. 1971).

Thus, the materiality of non-disclosed prior art is an important consideration in determining whether a duty to disclose it to the Office attaches to such prior art. But there must also be a deceitful intent in connection with any failure to disclose it before such failure is adjudged wrongful.

Factor of No Shepardson Testimony Explaining Non-Disclosure

A still further factor advanced by Respondents is that Shepardson never offered any explanation as to why the five items were not disclosed to the Office. There is nothing revealed in these items, when scrutinized, that mandates Shepardson's disentitlement to any claims he was seeking in his continuation-in-part application as to warrant a requirement for such an explanation. Examination of these items themselves exposes their lack of likelihood in changing the claims as allowed in the patent.

Shepardson testified that this was his first experience with patents. Nothing in the record suggests any attorney handling a Shepardson patent application had knowledge of any of the five non-disclosed items.

Under the circumstances, it is manifestly unfair and improper to consider Shepardson's lack of testimony explaining why he did not disclose the five items to the Office, as a factor which tends to justify the inference that the failure to disclose was "deliberate".

The illuminating fact piercing the obfuscation of Respondents is that there is absolutely no extrinsic evidence to make reasonable or warrant the lower Courts' inference that the non-disclosure was "deliberate". It is based *solely* on Shepardson's chargeable knowledge of the five non-disclosed items. This is not enough to supply the requisite element of wrongful intent. *United States v. U.S. Gypsum Co.*, 67 F.Supp. 397, 449-451 (D. D.C. 1946), rev'd. on other grounds, 333 U.S. 364 (1948), contains a good explanation of the principles of proof for making reasonable inferences.

Clearly Erroneous Findings *Re* "Material", "Misled" and "Inadvertent"

The findings of the Courts below that the five non-disclosed prior art items were "material" and "misled" the Office are clearly erroneous. In the first place, what the Court said about the patentability of claims 14 and 15 over all prior art is inconsistent with the conclusion of materiality and therefore destroys its propriety.

As to misleading the Patent Office, it must be remembered that claims 1, 2, 5, 6, 8, 11 and 17 were invalidated on *Grape Belt,* not on any of the five non-disclosed items. When the Examiner testified he would not have allowed the patent to issue in the form that it did, had he known about *Grape Belt* and the two theses (*Padget, Studer*), the value of his testimony is undermined because predicated on *Grape Belt.* The Examiner could have come to the same conclusion as the Courts below did, *i.e.* claims 1, 2, 5, 6, 8, 11 and 17 were invalid over *Grape Belt* but claims 12, 14 and 15 were not met by any prior art. Misleading the Office cannot be based on the Office's lack of knowledge of *Grape Belt,* because Shepardson was also unaware of it and therefore had no duty to disclose it.

The lower Courts said they did not find the failure to disclose the five items was "inadvertent". Since this statement immediately precedes one relating to a disclaimer filed after litigation commenced not being a prompt disclaimer, it is not clear whether the Courts had in mind the requirement of "inadvertence" under the oid disclaimer law, or whether it was intended as a general statement antithetical to "deliberate". In either context, the finding of no inadvertence is unwarranted, and therefore clearly erroneous.

For an appropriate disclaimer under current law, inadvertence is not a requisite.

Under all the circumstances, it is more plausible and hence reasonable to infer that Shepardson's failure to disclose the five items of purported prior art, if in fact there was any duty to disclose these items because of their incapability to have altered the result of the patent as issued, was inadvertent rather than deliberate. Even assuming *arguendo* that both inferences were equally probable to be drawn from the same facts, this would render the evidence equivocal, and Respondents then would not have met their burden of proving fraud by clear, unequivocal and convincing evidence.

Lower Courts Erred In Ruling Respondents Had Met Their Burden Of Proof

Under 35 U.S.C. §282, Respondents have the burden of proving invalidity. The burden of proof in a patent fraud case, as here, is that the fraud must be proven clearly, unequivocably and convincingly. *In Re Multidistrict Litigation Involving Frost Patent,* 540 F.2d 601, 603 (3rd Cir. 1976). It has been demonstrated that Respondents have failed to carry their burden, underscoring the error of the Courts below in stating otherwise.

Respondents' Brief in opposition, if anything, reinforces the compelling reasons for granting the petition for writ of certiorari.

Respectfully submitted,

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